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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,489	04/06/2000	Pericles Calias	G0651/7023 WGG	7399

7590 07/12/2002
KENT H. CHENG, ESQ.
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551 fifth Avenue, Suite 1210
New York, NY 10176

EXAMINER

BADIO, BARBARA P

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 07/12/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/543,489

Applicant(s)

CALIAS ET AL.

Examiner

Barbara P Badio, Ph.D.

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1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 3-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2 and 72-74 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

First Office Action on the Merits of a RCE

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 14, 2002 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of the Application

3. Because the present application is a RCE, the election of a composition comprising the compound of claim 2 carries over. Therefore, claim 1 and 3-71 stand withdrawn as being drawn to a nonelected invention. Claims 2 and 72-74 stand rejected as indicated below.

Claim Rejections - 35 USC § 102

4. The rejection of claim 2 under 35 USC 102(b) over Ito et al. ('151) is maintained and claims 72-74 are rejected under 35 102(b) over Ito et al. ('151).

73 - Cancelled
72 - M₂

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Applicant argues that the reference does not teach or suggest that EDU can be used as a pharmaceutical composition in the forms recited by the instant claims and that the presence specification states that the composition "may" contain other components. Applicant's argument was considered but not persuasive for the following reasons.

The examiner disagrees that in the art water alone is not a suitable pharmaceutical carrier for the claimed mode of administrations. Water is a well-known pharmaceutical carrier utilized in the pharmaceutical art may be utilized either alone or in association with other components.

The instant claims are drawn to a composition and, as stated in the previous Office Action, the recitation of intended use of the composition does not lend patentability to a known composition. Therefore, the recitation of the intended mode of administration does not lend patentability to the claimed invention. It is also noted that the reference teaches, in addition to the liquid composition, the composition in solid state (see col. 4, lines 30-35).

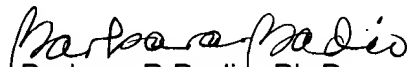
For these reasons and those given in previous Office Actions, the rejection of claim 2 under 35 USC 102(b) over Ito et al. ('151) is maintained and claims 72-74 are rejected under 35 102(b) over Ito et al. ('151).

Telephone Inquiry

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Barbara P Badio, Ph.D.
Primary Examiner
Art Unit 1616

BB
July 12, 2002